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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/908,852	08/08/1997	DONALD CARROLL ROE	5494CR	9941

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 06/18/2003

48

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/908,852

Applicant(s)

ROE ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9-13 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9-13 and 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 33. 6) ☐ Other: _____

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1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 4/23/03 has been entered.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1,4-7,9-13,16-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan et al. (3489148).

With respect to claims 1,4-7,9-11,13,16-20, Duncan discloses a topsheet 12, absorbent 11, and backsheet 11a. Duncan discloses that the topsheet has multiple discrete droplets (plurality of elements) of a lotion composition 14a. The discrete

droplets of lotion have macroscopic areas between them that have no lotion. The examiner considers Duncan to disclose a pattern. The recitation of pattern is broad and figure 1 is considered to disclose a pattern. Duncan discloses in column 3, lines 47-50 that the droplets have sizes ranging from 0.05-1.0mm. The droplets have predetermined sizes in the sense that they can range from 0.05-1.0mm in diameter. The disclosure found in column 2, lines 7-9 indicates that the use of a hydrophilic topsheet was known in the public domain as of 1-13-1970. Even though Duncan is mainly concerned with a hydrophobic topsheet this portion of the disclosure teaches that it was previously known to use lotion on a hydrophilic topsheet. The lotion of Duncan is fully capable of preventing the adherence of bowel movements to the skin of the wearer. Duncan does not disclose what the open percent area of the topsheet is. It is evident that Duncan does have some value for the percent open area, Duncan is just silent as to what this value is. In column 3 Duncan discusses and recognizes that the amount of lotion applied to the topsheet can be varied and that this will affect how much lotion is transferred to the wearer. Duncan also recognizes that the diameter of the discrete droplets of lotion can be varied. Duncan therefore recognizes that the percent open area can be varied (although Duncan does not specifically call it percent open area). Duncan recognizes that the amount (% open area) of lotion is a result effective variable (i.e. a variable which achieves a recognized result). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Duncan with the claimed percent open area. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation" *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

With respect to claims 12,13, the immobilizing agent is considered to be the viscosity additive disclosed in column 2, lines 20-44.

With respect to claim 21, see column 3, lines 40-44.

With respect to claim 22, stearic acid is a C(14)-C(22) fatty acid; therefore, Duncan anticipates this claim.

3. Claims 1,4-7,9-13,16-26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan et al. (3489148) in view of Buchalter (3896807).

Duncan discloses a topsheet 12, absorbent 11, and backsheet 11a. Duncan discloses that the topsheet has multiple discrete droplets (plurality of elements) of a lotion composition 14a. The discrete droplets of lotion have macroscopic areas between them that have no lotion. The examiner considers Duncan to disclose a pattern. The recitation of pattern is broad and figure 1 is considered to disclose a pattern. Duncan discloses in column 3, lines 47-50 that the droplets have sizes ranging from 0.05-1.0mm. The droplets have predetermined sizes in the sense that they can range from 0.05-1.0mm in diameter. The disclosure found in column 2, lines 7-9 indicates that the use of a hydrophilic topsheet was known in the public domain as of 1-13-1970. Even though Duncan is mainly concerned with a hydrophobic topsheet this portion of the disclosure teaches that it was known to use lotion on a hydrophilic topsheet. Duncan does not disclose the use of the specific lotions claimed or what the open area of the topsheet is. It is evident that Duncan does have some value for the percent open area, Duncan is just silent as to what this value is. In column 3 Duncan discusses and recognizes that the amount of lotion applied to the topsheet can be

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varied and that this will affect how much lotion is transferred to the wearer. Duncan also recognizes that the diameter of the discrete droplets of lotion can be varied. Duncan therefore recognizes that the percent open area can be varied (although Duncan does not specifically call it percent open area). Duncan recognizes that the amount (% open area) of lotion is a result effective variable (i.e. a variable which achieves a recognized result). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Duncan with the claimed percent open area. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation" *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Buchalter discloses an oil phase impregnant in the form of a non-oily solid that forms a cream upon the application of perspiration and heat that is used on articles such as facial masks, sanitary napkins, diapers, etc., where the cream is applied to the skin of a person. The wearer's skin will produce sufficient moisture and heat to cause emulsification of a portion of the oil phase. The substance is a dry non-oil, non-greasy, solid at room temperature and it is essentially free from water. The formulation is made from about 1% to about 99% and preferably from about 30% to about 70% of an oily material which includes mineral oil and petrolatum, and from about 99% to about 1% and preferably from about 30% to about 70% of an immobilizing agent. The resulting preparation can be applied to the article in a liquid phase and cooled to form a solid oil phase. The oil phase may additionally include, but are not limited to paraffin, vegetable oils, animal oils, and isopropyl palmitate. The oil phase is in the form of a dry, non-oily,

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non-sticky solid at room temperature, and comprises an oily material and one or more emulsifying agents and may include in addition, one or more emollients. The immobilizing agent or emulsifying agent includes cetyl alcohol, long chain fatty acid partial esters of a hexitol anhydride wherein the fatty acid has at least 6, preferably from 12 to 18 carbon atoms including the long chain fatty acid partial esters of sorbitan, sorbide, mannitan, and mannide and mixtures thereof. The emulsifying agent is considered to be the same as applicant's immobilizing agent. The lotion of Buchalter is fully capable of preventing the adherence of bowel movements to the skin of the wearer. It would have been obvious to one of ordinary skill in the art at the time the invention was to use the skin care composition of Buchalter on the diaper of Duncan (as disclosed by Duncan) so that the benefits of the skin care composition of Buchalter can be obtained on the article of Duncan

2. Applicant's arguments filed 4/23/03 have been fully considered but they are not persuasive.

With respect to the argument that the hydrophilic topsheet is not found in Duncan, the examiner disagrees. The article or product that Duncan is trying to improve upon is an article with a hydrophilic topsheet with discrete droplets of lotion, etc. Duncan uses a hydrophobic topsheet because he recognizes that a hydrophilic topsheet has certain disadvantages. See column 1, line 71 to column 2, line 9. A hydrophilic topsheet is disclosed by Duncan.

Applicant has stated that the claimed combination offers benefits that were not appreciated by Duncan or those skilled in the art prior to the disclosure of Duncan. It is

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not a requirement that a prior art reference disclose the benefits disclosed in the instant application to be used as prior art. This argument is non-persuasive.

Applicant also argues on page 7, first full paragraph, that Duncan still fails to teach or suggest the disposable article of the present invention that employs a hydrophilic topsheet onto which a lotion is applied in a pattern.....and the topsheet has a percent open area of from about 5% to about 99%. The examiner takes notice that there is not actual specific reasoning or explanation of why the noted claim limitations are not found in Duncan. Applicant respectfully asserted that it is absolutely not the case that Duncan discloses the elements noted by applicant on page 7 of the response, but not reasoning at all has been provided. This is an allegation of patentability with no reasoning to support the allegation. This argument is non-persuasive.

Applicant has stated that the examiner has not explained why the invention is considered obvious at the bottom of page 7. This is not the case and the examiner has clearly explained his position in the rejection of record. The rejection of record addresses each claimed element, whether it is found in Duncan or is deemed to be obvious to one of ordinary skill in the art.

With respect to the argument concerning the 103 using Buchalter as a secondary reference, the rationale for the traversal has nothing to do with what is claimed because the claims mention nothing about not allowing moisture from the skin mix with the lotion. The argument is not commensurate with the scope of the claims. The fact that the instant lotion is not dependent upon the presence of moisture from the skin of the wearer has nothing to do with the claims because they recite nothing of this

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nature. It must be shown why the claimed invention is novel, not why the disclosed invention is novel.

Applicant has stated that claims 33-37 are allowable over the 103 rejection of Warner in view of Buchalter. No rejection of Warner in view of Buchalter is in the current office action and claims 33-37 are not pending.

The last paragraph of the response which is mostly case law citations is noted.

3. This is a RCE of applicant's earlier Application No. 08/908852. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 703-308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

DR
June 16, 2003


DENNIS RUHL
PRIMARY EXAMINER